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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,299	12/03/2003	Brian Jones	60001.286US01	5350

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EXAMINER	
BOTTS, MICHAEL K	
ART UNIT	**PAPER NUMBER**
2176	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,299	JONES ET AL.	
	Examiner	Art Unit	
	Michael K. Botts	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on December 3, 2003.

2. Claims 1-21 have been examined, with claims 1, 8, and 15 being the independent claims.

3. Priority date is set to the filing date of this application.

4. Claims 15, 16, and 17 are objected to.

5. Claims 1-21 are rejected.

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 120 is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/187,060, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Specifically, independent claim 1 claims "indicating at least one error selected from a grammar error and a spelling error." See, claim 1, lines 5-6. The '060 application makes no mention of either a spelling or grammar error. The elements of spelling and grammar errors are not supported or enabled in the '060 application. Claims 2-7 depend from claim 1 and they are similarly without support or enablement from the '060 application.

Similarly, independent claims 8 and 15 claim elements of spelling and grammar errors and are also not supported or enabled by the '060 application. Accordingly, dependent claims 9-14, which depends from independent claim 8, and dependent claims 16-21, which depend from independent claim 15, are not supported or enabled by the '060 application on the same rationale.

Therefore, priority for the present application is set as of the date of its filing, December 3, 2003, and is denied priority dating to the filing of the '060 application.

The Specification

7. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.

Claims Objections

8. Claim 15 is objected to because of the following informalities: the word "and" is doubled in line 4. It is believed that the second "and" was a typo and that the applicants intended the word to be "an." The second "and" will be read as "an" for the remainder of this Office Action. Appropriate correction is required.

9. Claims 15, 16, and 17 are objected to for the use of the non-standard abbreviation "ML," which is believed to have been intended by the applicants to stand for "markup language." The abbreviation "ML" will be read as "markup language" for the remainder of this Office Action. In the interest of clarity of the claims is suggested that the claims be amended such that the phrase "markup language" is used instead of the abbreviation "ML."

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogilevsky (U.S. Patent 5,787,451), [hereinafter "Mogilevsky"], and further in view of

Munro, J., "StarOffice 6.0 Lives Up to its Name," PCMAG.com, May 23, 2002, last downloaded by the Examiner on November 11, 2005, from www.pcmag.com/print_article2/0,1217,a=27287,00.asp, downloaded pages 1-3, [hereinafter Munro].

Regarding **independent claim 1**, Mogilevsky in view of Munro teaches:

A computer-readable medium, comprising:

a first component for interpreting a word-processor document stored as an XML file; and

a second component for placing at least one marker within the word-processor document indicating at least one error selected from a grammar error and a spelling error.

(Mogilevsky teaches a word processor program with a spell checker, but does not teach an XML document. Specifically, see, Mogilevsky, col. 6, lines 34-37, teaching storing spelling state codes within the document.

Munro, teaches spell checking of an XML document, specifically with the StarOffice6.0 software program.

Mogilevsky and Munro are analogous art because they are from the same field of endeavor of spell checking text documents. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store spell checker markers within an XML document. The motivation for doing so would have been to spell check an XML document with the spell check markers within the word-processor document.)

Regarding **dependent claim 2**, Mogilevsky in view of Munro teaches:

The computer-readable medium of Claim 1, further comprising a third component for placing a proof state within the word-processor document.

(See, Mogilevsky, col. 1, lines 61-65, teaching status code (proof states) recording the spell checking proof of the document.)

Regarding **dependent claim 3**, Mogilevsky in view of Munro teaches:

The computer-readable medium of Claim 1, wherein the second component for placing the at least one marker within the word-processor document further comprises placing a start tag and an end tag within the word-processor document around the error.

(Mogilevsky does not specifically teach the use of start and end tags to mark text in XML. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.)

Regarding **dependent claim 4**, Mogilevsky in view of Munro teaches:

The computer-readable medium of Claim 3, wherein placing the start tag and the end tag within the word-processor document around the error, further comprises placing a grammar start tag and a grammar end tag around the grammar error and a spelling start tag and a spelling end tag around the spelling error.

(Mogilevsky does not specifically teach the use of start and end tags to mark text in XML. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.)

Regarding **dependent claim 5**, Mogilevsky in view of Munro teaches:

> *The computer-readable medium of Claim 2, wherein the third component for placing the proof state within the word-processor document, further comprises indicating when the word-processor document is in a clean state.*

(See, Mogilevsky, col. 7, lines 24-27, teaching a "clean" clean state as a flag indication that there are no misspellings.)

Regarding **dependent claim 6**, Mogilevsky in view of Munro teaches:

> *The computer-readable medium of Claim 2, wherein the third component for placing the proof state within the word-processor document, further comprises placing a spelling proof state property.*

(See, Mogilevsky, Figures 4 and 6, and col. 7, lines 38-45, teaching the spelling state property as "clean" or "dirty.")

Regarding **dependent claim 7**, Mogilevsky in view of Munro teaches:

> *The computer-readable medium of Claim 2, wherein the third component for placing the proof state within the word-processor document, further comprises placing a grammar proof state property.*

(Munro does not teach a grammar state property, however, it is inherent from the examination of the document that a state property may be recorded for the grammar state as well as for the spelling state property.)

Regarding **independent claim 8**, Mogilevsky in view of Munro teaches:

A method for indicating errors within a word-processor document, comprising:

interpreting a word-processor document stored as an XML file;

placing a first marker within the word-processor document indicating a start of at least one error selected from a grammar error and a spelling error; and

placing a second marker within the word-processor document indicating an end of the at least one error selected from the grammar error and the spelling error.

(Mogilevsky teaches a word processor program with a spell checker, but does not teach an XML document. Specifically, see, Mogilevsky, col. 6, lines 34-37, teaching storing spelling state codes within the document. Mogilevsky does not specifically teach the use of start and end tags to mark text in XML. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.

Munro, teaches spell checking of an XML document, specifically with the StarOffice6.0 software program.

Mogilevsky and Munro are analogous art because they are from the same field of endeavor of spell checking text documents. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store spell checker markers within an XML document. The motivation for doing so would have been to spell check an XML document with the spell check tag markers within the word-processor document.)

Regarding **dependent claim 9**, Mogilevsky in view of Munro teaches:

The method of Claim 8, further comprising placing a proof state within the word-processor document.

(See, Mogilevsky, col. 6, lines 50-55, teaching storing spelling state data in memory.)

Regarding **dependent claim 10**, Mogilevsky in view of Munro teaches:

The method of Claim 9, wherein placing the first marker and the second marker within the word-processor document, further comprises placing a grammar start tag and a grammar end tag around any grammar error.

(Mogilevsky does not specifically teach the use of start and end tags to mark text in XML. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.)

Regarding **dependent claim 11**, Mogilevsky in view of Munro teaches:

The method of Claim 9, wherein placing the first marker and the second marker within the word-processor document, further comprises placing a spelling start tag and a spelling end tag around any spelling error.

(Mogilevsky does not specifically teach the use of start and end tags to mark text in XML. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.)

Regarding **dependent claim 12**, Mogilevsky in view of Munro teaches:

The method of Claim 9, wherein placing the proof state within the word-processor document, further comprises indicating when the word-processor document is in a clean state and a dirty state.

(See, Mogilevsky, Figures 4 and 6, and col. 7, lines 38-45, teaching the spelling state property as "clean" or "dirty.")

Regarding **dependent claim 13**, Mogilevsky in view of Munro teaches:

The method of Claim 12, wherein placing the proof state within the word-processor document, further comprises placing a spelling proof state property.

(See, Mogilevsky, Figures 4 and 6, and col. 7, lines 38-45, teaching the spelling state property as "clean" or "dirty.")

Regarding **dependent claim 14**, Mogilevsky in view of Munro teaches:

The method of Claim 13, wherein placing the proof state within the word-processor document, further comprises placing a grammar proof state property.

(See, Mogilevsky, Figures 4 and 6, and col. 7, lines 38-45, teaching the spelling state property as "clean" or "dirty." Mogilevsky does not specifically teach a grammar proof state property, but such is inherent from the teaching to establish a spelling state property.)

Regarding **independent claim 15**, Mogilevsky in view of Munro teaches:

A system for indicating errors within a word-processor document, comprising:

a ML file output by a word processor that includes a first marker and a second marker indicating a start and and end of at least one error selected from a grammar error and a spelling error; and

a validation engine configured to validate the ML file; and

an application configured to read a ML file created in accordance with a schema.

(It is noted that a validating a markup language, in particular XML, with a schema is a standard inherent function for processing a markup language file. See, Castro, E., "XML for the World Wide Web, Visual Quickstart Guide," Peachpit Press, 2001, page 245. It would have been obvious for one of ordinary skill in the art at the time of the invention to validate a markup language file in accordance with a schema.

Mogilevsky teaches a word processor program with a spell checker, but does not teach a document in a markup language. Specifically, see, Mogilevsky, col. 6, lines 34-37, teaching storing spelling state codes within the document. Mogilevsky does not specifically teach the use of start and end tags to mark text in a markup language. However, it is inherent in a markup language document, specifically in an XML document, that tags are used to mark or designate items.

Munro, teaches spell checking of an XML document, specifically with the StarOffice6.0 software program.

Mogilevsky and Munro are analogous art because they are from the same field of endeavor of spell checking text documents. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store spell checker markers within an XML document. The motivation for doing so would have been to spell check an XML document with the spell check tag markers within the word-processor document.)

Regarding **dependent claim 16**, Mogilevsky in view of Munro teaches:

The system of Claim 15, wherein the ML file is an XML file.

(The rejection of claim 14 is applied to claim 15 as if stated in the entirety.)

Regarding **dependent claims 17-20**, claims 17-20 incorporate substantially similar subject matter as claimed in claims 6, 10, 11, and 12, respectively, and are rejected along the same rationale.)

Regarding **dependent claim 21**, Mogilevsky in view of Munro teaches:

The system of Claim 20, wherein the proof state further comprises a spelling proof state property and a grammar proof state property.

(See, Mogilevsky, Figures 4 and 6, and col. 7, lines 38-45, teaching the spelling state property as "clean" or "dirty." Mogilevsky does not specifically teach a grammar proof state property, but such is inherent from the teaching to establish a spelling state property.)

Conclusion

10. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Rogson, (U.S. Patent 6,918,086 B2), teaching a static update list and a captured list for recording misspelled words.

Angiulo, et al., (U.S. Patent 6,044,387), teaching spell check editing protocols.

Rodriguez, M., "XML::Twig," xmltwig.com, copyright 2003, downloaded pages 1-4, last downloaded by the Examiner on November 28, 2005 from: web.archive.org/web/20030422002120/http://www.xmltwig.com/xmltwig/tools/xml_spellcheck, teaching a program to spellcheck an XML document.

XMetal 1.0, Webreference.com, October 28, 1999, downloaded pages 1-2, last downloaded by the Examiner on November 28, 2005, from: www.webreference.com/html/watch/xmetal/5.html, teaching spell checking of XML documents in the XMetal 1.0 software program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB